

PATENT COOPERATION TREATY

MAY 19 2003

From the INTERNATIONAL SEARCHING AUTHORITY

PCT

To: HICKMAN PALERMO TRUONG & BECKER, LLP Attn. Palermo, Christopher 1600 Willow Street San Jose, CA 95125-5106 UNITED STATES OF AMERICA		HICKMAN PALERMO TRUONG & BECKER Atty Docket # <u>60036-0012</u> Initial <u>ms</u> Atty Paralegal <u>CJP</u> NOTIFICATION OF TRANSMITTAL OF THE INTERNATIONAL SEARCH REPORT Foreign <input checked="" type="checkbox"/> Country <u>PCT</u> OR THE DECLARATION Action <u>Article 34 Amendments</u> <u>w/ Demand</u> (PCT Rule 44.1) Reminders: 2 mo _____ 1 mo. <u>7/10/03</u> <u>2 wk.</u> _____ Action Due Date <u>8/10/03</u>	
		Date of mailing (day/month/year) 19/05/2003	
Applicant's or agent's file reference 60036-0012		FOR FURTHER ACTION See paragraphs 1 and 4 below	
International application No. PCT/US 03/00661		International filing date (day/month/year) 08/01/2003	
Applicant SVM MACHINING, INC.			

1. ☒ The applicant is hereby notified that the International Search Report has been established and is transmitted herewith.

Filing of amendments and statement under Article 19:

The applicant is entitled, if he so wishes, to amend the claims of the International Application (see Rule 46):

When? The time limit for filing such amendments is normally 2 months from the date of transmittal of the International Search Report; however, for more details, see the notes on the accompanying sheet.

Where? Directly to the International Bureau of WIPO
 34, chemin des Colombettes
 1211 Geneva 20, Switzerland
 Facsimile No.: (41-22) 740.14.35

For more detailed instructions, see the notes on the accompanying sheet.

2. ☐ The applicant is hereby notified that no International Search Report will be established and that the declaration under Article 17(2)(a) to that effect is transmitted herewith.

3. ☐ **With regard to the protest** against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:

☐ the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.


☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. **Further action(s):** The applicant is reminded of the following:

Shortly after **18 months** from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90bis.1 and 90bis.3, respectively, before the completion of the technical preparations for international publication.

Within **19 months** from the priority date, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later).

Within **20 months** from the priority date, the applicant must perform the prescribed acts for entry into the national phase before all designated Offices which have not been elected in the demand or in a later election within 19 months from the priority date or could not be elected because they are not bound by Chapter II.

Name and mailing address of the International Searching Authority  European Patent Office, P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk Tel. (+31-70) 340-2040, Tx. 31 651 epo nl, Fax: (+31-70) 340-3016	Authorized officer Cristina Rincón Ruiz
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NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the PCT Applicant's Guide, a publication of WIPO.

In these Notes, "Article", "Rule", and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions respectively.

INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

What parts of the international application may be amended?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

When?

Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

Where not to file the amendments?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

How?

Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

The amendments must be made in the language in which the international application is to be published.

What documents must/may accompany the amendments?

Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.

NOTES TO FORM PCT/ISA/220 (continued)

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

The following examples illustrate the manner in which amendments must be explained in the accompanying letter:

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added." or
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

"Statement under article 19(1)" (Rule 46.4)

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)).

The statement will be published with the international application and the amended claims.

It must be in the language in which the international application is to be published.

It must be brief, not exceeding 500 words if in English or if translated into English.

It should not be confused with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It may not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

Consequence if a demand for international preliminary examination has already been filed

If, at the time of filing any amendments under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the same time of filing the amendments with the International Bureau, also file a copy of such amendments with the International Preliminary Examining Authority (see Rule 62.2(a), first sentence).

Consequence with regard to translation of the international application for entry into the national phase

The applicant's attention is drawn to the fact that, where upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see Volume II of the PCT Applicant's Guide.

INTERNET COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference 60036-0012	FOR FURTHER ACTION see Notification of Transmittal of International Search Report (Form PCT/ISA/220) as well as, where applicable, item 5 below.	
International application No. PCT/US 03/ 00661	International filing date (day/month/year) 08/01/2003	(Earliest) Priority Date (day/month/year) 10/01/2002
Applicant SVM MACHINING, INC.		

This International Search Report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This International Search Report consists of a total of 5 sheets.

☒ It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the report

- a. With regard to the **language**, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ the international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).

- b. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international search was carried out on the basis of the sequence listing :

☐ contained in the international application in written form.

☐ filed together with the international application in computer readable form.

☐ furnished subsequently to this Authority in written form.

☐ furnished subsequently to this Authority in computer readable form.

☐ the statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

☐ the statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished

2. ☐ **Certain claims were found unsearchable** (See Box I).

3. ☐ **Unity of invention is lacking** (see Box II).

4. With regard to the **title**,

☒ the text is approved as submitted by the applicant.

☐ the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,

☐ the text is approved as submitted by the applicant.

☒ the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. The figure of the **drawings** to be published with the abstract is Figure No.

☒ as suggested by the applicant.

☐ because the applicant failed to suggest a figure.

☐ because this figure better characterizes the invention.

2 _____
☐ None of the figures.

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US 03/00661

Box III TEXT OF THE ABSTRACT (Continuation of item 5 of the first sheet)

A tool for cleaning a watercraft speedometer comprises a body (100), an extraction tip (111) extending therefrom, and at least one edge on the extraction tip (111) that can catch matter in the cavity (201) . The extraction tip (111) is attached to the body (100) and is approximately the size and shape to fit into an intake cavity of a speedometer mechanism so as not to damage the intake cavity (201) . The extraction tip edge is used for extracting debris from the intake cavity.

INTERNATIONAL SEARCH REPORT

International Application No

PCT/US 03/00661

A. CLASSIFICATION OF SUBJECT MATTER
 IPC 7 B63B59/08 B08B9/04

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

IPC 7 B63B B08B

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)

EPO-Internal

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	US 3 824 646 A (JAI M) 23 July 1974 (1974-07-23)	1,4,5, 11,12, 14,17-20
Y	column 3; line 59 - line 62; figure 78	13,15, 16,21,22
X	US 5 937 473 A (LISOWSKI WALTER E) 17 August 1999 (1999-08-17)	1
Y	the whole document	22-24
X	DE 332 905 C (HERMANN WINARSKY JR) 11 February 1921 (1921-02-11)	1,7,9
Y	page 1, line 35 - line 40; figures 1-5	8,10,15, 16
X	US 5 493 748 A (SANTO DAVID) 27 February 1996 (1996-02-27)	1,6
Y	figures 1,2	13,22-24
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☒ Further documents are listed in the continuation of box C.

☒ Patent family members are listed in annex.

* Special categories of cited documents :

- *A* document defining the general state of the art which is not considered to be of particular relevance
- *E* earlier document but published on or after the international filing date
- *L* document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
- *O* document referring to an oral disclosure, use, exhibition or other means
- *P* document published prior to the international filing date but later than the priority date claimed

- *T* later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
- *X* document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
- *Y* document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.
- *&* document member of the same patent family

Date of the actual completion of the international search

12 May 2003

Date of mailing of the international search report

19/05/2003

Name and mailing address of the ISA

European Patent Office, P.B. 5818 Patentlaan 2
 NL - 2280 HV Rijswijk
 Tel. (+31-70) 340-2040, Tx. 31 651 epo nl,
 Fax: (+31-70) 340-3016

Authorized officer

DE SENA HERNAND..., A

INTERNATIONAL SEARCH REPORT

International Application No

PCT/US 03/00661

C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	GB 809 526 A (HERBERT NORRIS; WILLIAM NORMAN DEARN) 25 February 1959 (1959-02-25) the whole document ---	1, 17-20
X	DE 940 460 C (WILLY UHLIG FREIBERG SA) 15 March 1956 (1956-03-15) page 2, line 96 - line 120; figures 2-5 ---	1-4
X	US 1 965 128 A (MILLER HARRY J) 3 July 1934 (1934-07-03) the whole document ---	1
Y	US 6 332 819 B1 (EMMONS JERROLD K) 25 December 2001 (2001-12-25) figures 1-6 ---	8, 16, 21, 24
Y	US 4 716 613 A (IRWIN LAWRENCE F) 5 January 1988 (1988-01-05) column 5, line 24 - line 30; figures 1-6 -----	10

INTERNATIONAL SEARCH REPORT

Information on patent family members

International Application No

PCT/US 03/00661

Patent document cited in search report		Publication date	Patent family member(s)	Publication date
US 3824646	A	23-07-1974	CA 1001810 A1	21-12-1976
US 5937473	A	17-08-1999	NONE	
DE 332905	C	11-02-1921	NONE	
US 5493748	A	27-02-1996	NONE	
GB 809526	A	25-02-1959	NONE	
DE 940460	C	15-03-1956	NONE	
US 1965128	A	03-07-1934	NONE	
US 6332819	B1	25-12-2001	NONE	
US 4716613	A	05-01-1988	AU 579565 B2	24-11-1988
			AU 6707986 A	01-10-1987
			CA 1273161 A1	28-08-1990
			CN 86108508 A	29-06-1988
			DE 3641969 A1	01-10-1987
			FR 2596300 A1	02-10-1987
			GB 2188393 A , B	30-09-1987
			JP 1669911 C	12-06-1992
			JP 3034992 B	24-05-1991
			JP 62227481 A	06-10-1987

WRITTEN OPINION

Form PCT/IPEA/408 (Box V) (July 1998)
FILE COPY - DO NOT MAIL

International application No.

PCT/US03/00661

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. statement

Novelty (N)	Claims	<u>7,8,15,16,21-24</u>	YES
	Claims	<u>1-6,9-14,17-20</u>	NO
Inventive Step (IS)	Claims	<u>NONE</u>	YES
	Claims	<u>1-24</u>	NO
Industrial Applicability (IA)	Claims	<u>1-24</u>	YES
	Claims	<u>NONE</u>	NO

2. citations and explanations

Claims 1-3 and 10 lack novelty under PCT Article 33(2) as being anticipated by Buchmann-Ribary '013.

Buchmann-Ribary '013 teaches a tool for scraping or cleaning comprising a body, a tip a which can serve as an extraction tip extending outwardly from the body wherein the tip a is dimensioned to fit within an intake cavity (merely relative), and has edges formed in the tip and capable of catching matter in the intake cavity. The body (handle) is in the form of a pin vise at d,f in Figs. 1 and 2.

As for the tool being used to clean a watercraft speedometer, it has been held that with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations and merely involves intended use. The recitation that the tip has a length approximately equal to that of the intake cavity also involves intended use and also would be merely relative depending on the size of a cavity to be cleaned.

Claims 1-4, 9, 11, 12, 14 and 17-19 lack novelty under PCT Article 33(2) as being anticipated by Brookhart '635.

Brookhart '635 teaches a tool for scraping or cleaning a tube comprising a body or manual grasping means (Fig. 2), a tip which can serve as an extraction tip extending outwardly from the body wherein the tip is dimensioned to fit within an intake cavity (merely relative), and has edges formed in the tip and capable of catching matter in the intake cavity as well as barbs rearwardly extending that can withdraw matter from a tube. The tip is deemed to be a "drill" or "drill bit" fixed in the body. Typically, it is noted that a "drill" usually is associated with some type of rotating means for the "drill." Clearly, the claims do not require any such structure.

As for the tool being used to clean a watercraft speedometer, it has been held that with respect to the manner in (Continued on Supplemental Sheet.)

WRITTEN OPINION

Form PCT/IPEA/408 (Supplemental Box) (July 1998)
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International application No.

PCT/US03/00661

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

Sheet 10

TIME LIMIT:

The time limit set for response to a Written Opinion may not be extended. 37 CFR 1.484(d). Any response received after the expiration of the time limit set in the Written Opinion will not be considered in preparing the International Preliminary Examination Report.

V. 2. REASONED STATEMENTS - CITATIONS AND EXPLANATIONS (Continued):

which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations and merely involves intended use. The recitation that the tip has a length approximately equal to that of the intake cavity also involves intended use and also would be merely relative depending on the size of a cavity to be cleaned.

Claims 1-6, 11-14 and 17-20 lack novelty under PCT Article 33(2) as being anticipated by Sauer '888.

Sauer '888 teaches a tool for scraping or cleaning a tube comprising a body or manual grasping means 21, a tip 60 (Fig. 5) which can serve as an extraction tip extending outwardly from the body wherein the tip is dimensioned to fit within an intake cavity (merely relative) and has edges formed in the tip and capable of catching matter in the intake cavity, and a securable and removable closure or cap 34 for covering the "drill" (Figs. 2 and 4). The tip is deemed to be a "drill" or "drill bit" fixed in the body. Typically, it is noted that a "drill" usually is associated with some type of rotating means for the "drill." Clearly, the claims do not require any such structure.

As for the tool being used to clean a watercraft speedometer, it has been held that with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations and merely involves intended use. The recitation that the tip has a length approximately equal to that of the intake cavity also involves intended use and also would be merely relative depending on the size of a cavity to be cleaned.

Claims 7, 8, 15, 16, 22 and 23 lack an inventive step under PCT Article 33(3) as being obvious over Sauer '888 in view of Borst '240.

Sauer '888 teaches all of the recited subject matter as set forth above with the exception of the closure having a plurality of female threads that mate with corresponding male threads formed on the body and the body having a hole for accepting a flotation device. Borst '240 discloses a closure 10 having a plurality of female threads that mate with corresponding male threads 17 formed on the body and a hole 19. It would have been obvious to one of ordinary skill in the art to have provided Sauer's closure with a plurality of female threads that mate with corresponding male threads formed on the body for the purpose of providing a secure attachment of the closure to body and to avoid loss of the closure and to have a hole on the body for accepting a flotation device as suggested by Borst.

Claim 24 lacks an inventive step under PCT Article 33(3) as being obvious over the prior art as applied in the immediately preceding paragraph and further in view of Field '593.

Field '593 teaches a hole 13 in a closure. It would have been obvious to one of ordinary skill to have provided the modified Sauer device with a hole in the closure as suggested by Field for accepting some type of flotation device.

Claim 21 lacks an inventive step under PCT Article 33(3) as being obvious over Sauer '888 in view of Borst '240 and Field '593.

Sauer '888 teaches all of the recited subject matter as set forth above with the exception of the closure having a plurality of female threads that mate with corresponding male threads formed on the body and the body having a hole for accepting a flotation device.

Borst '240 discloses a closure 10 having a plurality of female threads that mate with corresponding male threads 17

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

Sheet 11

formed on the body and a hole 19.

Field '593 teaches a hole 13 in a closure.

It would have been obvious to one of ordinary skill in the art to have provided Sauer's closure with a plurality of female threads that mate with corresponding male threads formed on the body for the purpose of providing a secure attachment of the closure to body and to avoid loss of the closure as suggested by Borst and to have further provided a hole on the body for accepting a floatation device as suggested by Field.

----- NEW CITATIONS -----

US 1,085,240 A (BORST) 27 JANUARY 1914, see entire document.

US 1,674,593 A (FIELD) 19 JUNE 1928, see entire document.

US 2,629,888 A (SAUER) 03 MARCH 1953, see entire document.

US 4,669,635 A (BROOKHART) 02 JUNE 1987, see entire document.

CH 120013 (BUCHMANN-RIBARY) 16 MAY 1927, see entire document.